



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/805,652

03/13/2001

D. Laksen Sirimanne

412692000401

4202

34263 7590 04/26/2007
O'MELVENY & MYERS LLP
610 NEWPORT CENTER DRIVE
17TH FLOOR
NEWPORT BEACH, CA 92660

EXAMINER

SMITH, RUTH S

ART UNIT

PAPER NUMBER

3737

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
----------------------------------------	-----------	---------------

3 MONTHS

04/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/805,652	Applicant(s) SIRIMANNE ET AL.	
	Examiner Ruth S. Smith	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31, 33, 34, 109 and 110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 33, 34, 109 and 110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/29/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 61,102 of U.S. Patent No. 6,371,904. Although the conflicting claims are not identical, they are not patentably distinct from each other because it involves an obvious broadening of the patented claims. Both claim sets include at least two implantable bioabsorbable bodies and a marker affixed to at least one of the markers.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 36 of copending Application No. 10/114,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 involves an obvious broadening of claim 36. Both claim sets include at least two implantable bioabsorbable bodies and a marker affixed to at least one of the markers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 38 of copending Application No. 10/960,618. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have carried out the method of claim 38 using the device of claim 1. In view of the recitation of at least one bioabsorbable body in claim 38, it would have been obvious to have provided at least two bodies.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 109,128,152,177 of copending Application No. 10/960,622. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have carried out the method of claims 128,177 using the device of claim 1. In view of the recitation of at least one bioabsorbable body in claims 109,128,152,177, it would have been obvious to have provided at least two bodies.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,7,13-15,23,24,26,27,31,33,109,110 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et al (6,080,099). The claims are directly readable on the embodiment shown in figure 12 of Slater et al. Figure 12 discloses seeds containing a radioactive isotope and a radiopaque marker connected by a bioabsorbable body. Slater et al disclose that 50 to 100 seeds are implanted at a treatment site. Therefore, the implantation of these seeds would include at least two separately implantable bioabsorbable bodies and a marker. With regard to claim 4, the marker comprises a bioabsorbable material. With regard to claim 13, the bodies are inherently palpable. With regard to claim 14, as seen in figure 12, with respect to opening 902 or 904, a marker is located within a portion of the bioabsorbable body. Claim 26 is considered to be a product-by-process claim and the manner in which the product is made fails to impose any further structural limitations on the claim. With regard to claim 31, the body 900 has an irregular shape. With regard to claim 33, openings 902,904 are considered to be pores.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5,6,8-12,16,18-22,25,28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. Slater et al disclose seeds containing a radioactive isotope and a radiopaque marker connected by a bioabsorbable body. Slater et al disclose that 50 to 100 seeds are implanted at a treatment site. Therefore, the implantation of these seeds would include at least two separately implantable bioabsorbable bodies and a marker. With respect to claims 5,6,8,18,28, in the absence of any showing of criticality, the specific material used to provide the bioabsorbable body would have been an obvious design choice of known equivalents in the art. With respect to claims 9-12, the specific material used for the marker to make it visible would have been obvious to one skilled in the art based upon the type of imaging modality used. With regard to claim 16, it is a well-known expedient in the medical art to provide a pain killing substance in combination with a therapeutic procedure so as to reduce the pain that the implantation can cause. Therefore, it would have been obvious to one skilled in the art to have provided a pain killing substance to the patient in order to make the procedure less uncomfortable. With regard to claims 19-22,25, in the absence of any showing of criticality, the specific shape of the marker used would have been an obvious design choice of known equivalents in the art. With regard to claims 29, 30, in the absence of any showing of criticality, the specific shape of the bioabsorbable body would have been an obvious design choice of known equivalents.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al in view of Good (6,666,811). Slater et al disclose seeds containing a radioactive isotope and a radiopaque marker connected by a bioabsorbable body. Slater et al disclose that 50 to 100 seeds are implanted at a treatment site. Therefore, the implantation of these seeds would include at least two separately implantable bioabsorbable bodies and a marker. Slater et al fails to disclose the use of a hemostatic material. Good discloses an implantable seed including a hemostatic material enabling

it to be easily implanted in the tissue. It would have been obvious to one skilled in the art to have modified Slater et al such that it includes a hemostatic material which enhances its ability to be implanted in the body.

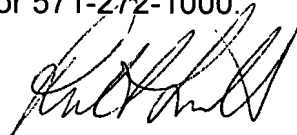
Response to Arguments

Applicant's arguments with respect to claims 1-31,33,34,109-110 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ruth S. Smith
Primary Examiner
Art Unit 3737